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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/347,496	07/02/99	XU	J 21021.471C1

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SEED INTELLECTUAL PROPERTY LAW GROUP PLL
701 FIFTH AVE
SUITE 6300
SEATTLE WA 98104-7092

EXAMINER

SOUAYA, J

ART UNIT	PAPER NUMBER
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1655

10

DATE MAILED:

12/14/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/347,496

Applicant(s)

Jiangchun Xu

Examiner

Jehanne Souaya

Group Art Unit

1655



☒ Responsive to communication(s) filed on Nov 22, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-78 is/are pending in the application.

Of the above, claim(s) 1-64 and 71-75 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-78 are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Applicant should note that upon election of group XII, the case was transferred. The new examiner is Jehanne Souaya in art unit 1655. Please direct all subsequent correspondence to her.

Election/Restriction

1. Applicant's written response (11/22/00) to the restriction requirement mailed September 11, 2000 has been noted. Consequently, the claims from Group XII, 65-70 and 76-78 will be examined in a subsequent action on the merits. The following action is a further restriction requirement to the claimed invention. In the previous response (11/22/00) applicants also elected SEQ ID NOS: 18, 23, 25, 35, 38, 40-42, 45, and 120 to be searched, however these sequences are to patentably distinct species. Applicant is therefore required to elect a single nucleic acid sequence to be examined.

By statute, "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." 35 U.S.C. 121. Pursuant to this statute, the rules provide that "[i]f two or more independent and distinct inventions are claimed in a single application, the examiner in his action shall require the applicant... to elect that invention to which his claim shall be restricted." 37 CFR 1.142 (a). See also 37 CFR 1.141(a).

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Nucleotide sequences encoding different proteins are structurally distinct **chemical compounds** and are unrelated to one another. These sequences are thus deemed to **normally constitute independent and distinct inventions** within the meaning of 35 U.S.C. 121. **Absent evidence** to the contrary, each such nucleotide sequences are presumed to represent **an independent and distinct invention**, subject to restriction requirement pursuant to 35 USC 121 and 37 CFR 1.141.

Should applicant traverse on the ground that the species are not patentably **distinct**, applicant should submit evidence or identify such evidence now of record showing **the species to be obvious variants** or clearly admit on the record that this is the case. In either instance, **if the examiner finds one of the inventions unpatentable over the prior art**, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. A telephone call was made to Gary Myles on December 7, 2000 to request **an oral election to the above restriction requirement**, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must **include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143)**.

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3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jehanne Souaya whose telephone number is (703)308-6565. The examiner can normally be reached Monday-Thursday from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for this Group is (703) 305-3014.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Jehanne Souaya
Jehanne Souaya
Patent examiner
December 11, 2000

Lisa B. Arthur
LISA B. ARTHUR
PRIMARY EXAMINER
GROUP 1800 1600